

REMARKS/ARGUMENT

Favorable reconsideration of this application is respectfully requested.

Claims 1-9 and 11 are presently pending, Claim 10 having been withdrawn from consideration without prejudice pursuant to a previous restriction requirement. Claims 1-9 are amended herewith. Claim 11 is new. No new matter has been added and support for the amendments is found throughout the Specification.

In the Office Action, it was asserted as follow: (1) Claims 1-9 were rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter; (2) Claims 3, 5 and 7-9 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness; and (3) Claims 1-9 were rejected under 35 U.S.C. § 103 as being unpatentable over the combination of U.S. Patent No. 5,629,980 (“Stefik”) and U.S. Patent No. 5,563,946 (“Cooper”). Applicants respectfully traverse these objections.

By way of background, the inventions claimed in the present application are directed to content delivery systems for the delivery of the content of licensed, copyrighted works from content providers to users who have systems containing multiple apparatuses that are capable of receiving and using such works. Applicants herein recognized that, in the prior art, it can be a time-consuming and tedious chore for a user who has obtained a licensed copy of a copyrighted work to move the contents of that work from one apparatus in the user’s system to another apparatus in the user’s system. Such difficulties can be due, for example, to restrictions placed in the license to the work by the copyright owner. Such restrictions can limit or even prevent the transfer of the contents of a licensed work from one device to other devices.

In order to make the transfer of a copyrighted work from one apparatus in a system to another apparatus in the system faster and more flexible, the present application discloses, in

one non-limiting embodiment, a content delivery system for delivering contents of a copyrighted work from one client apparatus to another client apparatus of the user. The system comprises: registering means for registering each of said clients of said user in order to acquire customer-related information; customer-related information managing means for managing said customer-related information; content providing means which, in response to a request from any one of said clients, provides content to the requesting client; first license granting means which, in response to a request from the requesting client having acquired the content from said content providing means, issues said requesting client a first license for the acquired content; and second license granting means which, after said user has moved the acquired content from said requesting client to another client of the same user, issues said another client a second license for the moved acquired content.

The systems of the present invention make it possible for a user who has multiple clients in one system to readily share the contents of a copyrighted work while still protecting the copyright in the contents of the work. The system of the present invention thus overcomes problems associated with inflexible single-license systems, which are set at the time the work is first created and/or first distributed. Such single-license systems may not allow a transfer of a user's work from one client to another, or they may do so pursuant to terms which are pre-determined by the copyright owner and attached to the work, and thus, those rights are fixed. These and other limitations inherent in a single-licensing system for distributing content may be overcome by the use of the present invention.

With respect to the rejection of Claims 1-9 under 35 U.S.C. § 101, Applicants respectfully point out that Claims 1-8 are each directed to an apparatus and are written in means-plus-function format pursuant to 35 U.S.C. §112, paragraph 6. The Office Action does not provide any reasoned explanation as to *why* these apparatus claims are deemed non-statutory.

Instead, the Office Action asserts that “features” recited in the claims are described in the Specification as “executable client applications.” Therefore, according to the Office Action, Claims 1-8 are directed towards “software per se.” Yet, as is evident from the plain language of each of Claims 1-8 themselves, none of those claims is directed to computer programs. On the contrary, Claims 1-8 are apparatus claims, which are statutory and plainly meet the requirements of 35 U.S.C. § 101. Similarly, newly-submitted Claim 11 is an apparatus claim that identifies specific structure. Furthermore, as the elements in Claim 11 are similar to those means-plus-function elements recited in Claim 1, it should be readily apparent that Claim 1 is in fact statutory and is not directed to “software per se.” Similarly, Claim 9, which also has been amended, is directed to statutory subject matter.

To the extent that the Office is taking the position that the inclusion of a software element in an otherwise statutory apparatus claim somehow takes the claim outside the realm of statutory subject matter, the Office is reminded that:

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed **as part of an otherwise statutory manufacture or machine**. In such a case, the claim **remains statutory irrespective of the fact that a computer program is included in the claim.**¹ (emphasis added)

Accordingly, should this rejection be maintained in a future communication, Applicants respectfully request that the Office provide substantial evidence as to how Claims 1-9 can be considered claims to computer “software per se” and how the means-plus-function elements, as recited in Claims 1-8, are interpreted as mandated by M.P.E.P. § 2182-82. Applicants respectfully request that the rejection of Claims 1-9 under 35 U.S.C. § 101 be withdrawn.

Claims 3, 5 and 7-9 also stand rejected under 35 U.S.C. § 112, second paragraph. As noted above, these claims have been amended. As amended, the claims no longer include the

¹ See MPEP Section 2106.01 I.

elements that were objected to in the Office Action. Specifically, Claim 3 no longer includes the “and/or” element; Claim 5 (and thus, the claims depending from Claim 5) no longer include the “legitimate” element; and Claim 7 no longer includes the “difference” element. Accordingly, Applicants respectfully request that the rejection of Claims 3, 5 and 7-9 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claims 1-9 stand rejected under 35 U.S.C. § 103 as obvious over Stefik in view of Cooper. Applicants respectfully traverse this rejection.

Stefik is directed to a system for controlling the use and distribution of copyrighted digital works. In Stefik, an owner of a copyrighted digital work defines and attaches to that work certain usage rights for the work. Those usage rights define how the digital work may be used and further distributed. The digital works and their associated usage rights are stored in a secure repository and may be accessed only by other secure repositories.

The Office Action asserts that Stefik discloses each and every limitation recited in independent Claim 1, except for the registering means limitation (which, according to the Office Action, is disclosed in Cooper). Applicants respectfully disagree with the Office Action’s conclusion that the limitations of Claim 1 are disclosed or suggested by the combination of Stefik and Cooper.

By way of example, the Office Action asserts that Stefik discloses “second license granting means which, after the user has moved the content from one client to another in the possession of the same user, grants said user a license for the moved content.” In support of this assertion, the Office Action relies upon Col. 11, line 30 of the applied reference and the associated discussion therein under the heading “Attaching Usage Rights to a Digital Work.”

As a preliminary matter, Claim 1 has been amended herewith. As revised, the limitation in question recites, “second license granting means which, after said user has moved the acquired content from said requesting client to another client of the same user,

issues said another client, from a second content providing means, a second license for the moved acquired content.” These features are neither recited in, nor suggested by, Stefik.

Stefik describes a distribution mechanism wherein “usage rights are treated as part of the digital work.” According to Stefik, “As the digital work is distributed, the scope of granted usage rights will remain the same or may be narrowed.” Stefik further states that, “For example, when a digital work is transferred from a document server to a repository, the usage rights may include the right to loan a copy for a predetermined period of time (called the original rights). When the repository loans out a copy of the digital work, the usage rights in the loaner copy (called the next set of rights) could be set to prohibit any further rights to loan out the copy.” Significantly, the “next set of rights” is not a new or second license, nor is it a “child” license as asserted in the Office Action. To the contrary, Stefik clearly provides that the “next set of rights” are “attached to the digital work as it is transported.” Stefik, Col. 11, lines 30-58. That is, they are a part of the original work and constitute the limited rights that were granted in one, and only one, license.

As is evident from the discussion above, Stefik is directed to a single license in a work. This single license, which is part of the work itself, is attached to the work as it is transported. As the work is distributed, the scope of the digital rights granted by this single license “will remain the same or may be narrowed.” This type of single license of varying scope does not transform the single license into two licenses. Nor does it teach or suggest granting a first license, in response to a request from a client of a user, and then granting a second license to the user after the user has moved the content from one client to another client of the same user. Nor does it teach or suggest receiving a first license from a first content provider and a second license from a second content provider.

Furthermore, as is apparent from Stefik, the single license is incorporated into the digital work at the time it is created. Therefore, while it may be pre-set to have different

scopes of usage, it is a static license the terms of which are already set when the work is made. This is an inflexible system because, as Stefik makes clear, the single license could be set to prohibit or limit future usage rights as the work is distributed. This type of inflexible licensing apparatus teaches away from the presently claimed invention, which seeks to avoid the problems associated with such limited licenses and to make it easier for a user who has multiple clients to more readily transport, and to, thereafter, fully utilize a work, after it is transported from one client to another.

For example, in the system in Stefik, if the single license -- pre-set at the time the work is created and attached to the work -- prohibits or limits future usage rights as the work is distributed, then a user of a multiple client system might be unable to transport the work from a first client and then to obtain a license to use that same work in a second client. This inflexibility of the single-license system is completely contrary to the scope of the present invention. Nothing in Stefik teaches or suggests the inventive solution to the problem of pre-set single licenses that the present invention attempts to solve. The present invention allows multiple clients in a system to obtain from respective content providers their own respective licenses in the work. Consequently, Stefik fails to teach or suggest the invention as claimed in Claim 1.

The Office Action also asserts that Stefik discloses each and every one of the limitations recited in dependent Claims 2-7. Applicant respectfully disagrees with the Office Action's characterizations of the reference.

In Claim 2, by way of example, it is recited that the customer-related information apparatus manages "a table of correspondences between leaf ID's and client ID's, a table of correspondences between client ID's and user ID's, a table of correspondences between content ID's and license ID's, a table of correspondences between user ID's and the content ID's of downloaded content, and a table of correspondences between user ID's and the

license ID's of downloaded licenses.” In support of this assertion, the Office Action states, without explanation or analysis, that Stefik discloses each of these elements in Figures 14 and 15. Neither of those figures, however, nor the discussion in Stefik associated with those figures, discloses or suggests any of the features of Claim 2. Applicants, therefore, believe that Stefik fails to disclose or suggest Claim 2. Applicants respectfully request that, if a future Office Action is issued which relies on Stefik as disclosing the elements of Claim 2, then the Office Action should please specify, on a limitation-by-limitation basis, precisely where (*i.e.*, by col. and line number, or exact item in any figure) each one of the features recited in Claim 2 is correspondingly described in the reference.

Claims 2 through 7 all depend from independent Claim 1. For the reasons discussed above, Claim 1 is not rendered obvious based upon Stefik. Furthermore, nothing described or disclosed in Cooper overcomes the deficiencies in Stefik. Accordingly, Claims 2 through 7 patentably define over the recited references.

Finally, in the Office Action, Claims 8 and 9 were rejected as not patentably distinct from Claims 1-7. For the reasons discussed above, Claims 8 and 9 (as amended herewith), do patentably define over the recited references. Accordingly, Claims 8 and 9 also should be allowed.

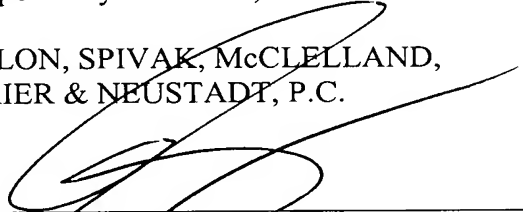
New Claim 11 has been added by this amendment. It is respectfully submitted that Claim 11 also patentably defines over the applied references for the reasons stated above.

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In sum, Claims 1-9, and 11 of the present application recite statutory subject matter, are definite, and patentably define over the recited references. Accordingly, it is respectfully submitted that the present application is in condition for allowance, and a favorable decision to that effect is respectfully requested.

Respectfully submitted,

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